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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,389	07/26/2001	Sean M. O'Hara	10010169-1	7790

7590 06/07/2005

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EXAMINER

MILIA, MARK R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,389

Applicant(s)

O'HARA ET AL.

Examiner

Mark R. Milia

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/26/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 9-12, 14, 18-21, 23, 27-33, 35-39, 41, 45-51, and 53-54 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6322260 to Manico et al.

Regarding claim 1, Manico discloses a method for printing an image directly from a film using a printer, where the printer may also function as a printer for a computer, comprising the steps of: inserting the film into a film slot of the printer (see Figs. 1, 10c, and 15, column 4 lines 3-5 and 22-36, and column 6 lines 41-56), scanning at least one selected digital image from the film (see column 4 line 61-column 5 line 8), storing the at least one digital image that was scanned in memory (see Figs. 10e, 10g, and 15 (314) and column 9 lines 42-44, reference shows that a user can chose to store the images that have been scanned into the system and which will be stored in computer memory), and printing the at least one digital image (see column 10 line 54-column 11 line 12).

Regarding claim 10, Manico discloses a method for using a printer to provide at least one print from a film, where the printer may also function as a printer for a computer, comprising the steps of: scanning a desired portion of the film in the printer to provide a digital image (see column 4 line 61-column 5 line 8, column 7 lines 13-19, and column 9 lines 1-6) and printing the digital image (see column 10 line 54-column 11 line 12).

Regarding claim 19, Manico discloses a printer for, as well as printing output from a computer, printing images directly from a film, comprising: at least one paper-feeding slot, arranged to allow paper to feed into a printing mechanism of the printer (see Fig. 14 (232)), at least one film-feeding slot, arranged to feed film into a scanner (see Figs. 1, 10c, and 15, column 4 lines 3-5 and 22-36, and column 6 lines 41-56), the scanner, coupled to a control unit, for scanning at least one image from the film and storing at least one image in a memory (see Figs. 1 (40), 10g, and 15 (314) and column 4 line 61-column 5 line 8), the memory, coupled to the scanner and to the control unit, for storing the at least one image that is scanned (see Fig. 10g and 15 (314)), the printing mechanism, coupled to the control unit and arranged to receive paper from the paper-feeding slot, for printing the at least one image that is scanned (see Fig. 14 and column 10 line 54-column 11 line 12), and the control unit, coupled to the printing mechanism, the memory, the scanner and arranged to initiate feeding of the paper into the printing mechanism and the film into the scanner in a predetermined fashion, for, in response to user input, causing the scanner to scan a selected portion of the film to provide the at least one image, store the at least one image in the memory and print the

at least one image on the paper (see column 6 lines 22-35, reference states that the computer is the central control unit for the entire system and interacts with all the attached devices).

Regarding claim 37, Manico discloses a printer for, as well as printing output from a computer, printing images directly from a film, comprising: at least one paper-feeding slot, arranged to allow paper to feed into a printing mechanism of the printer (see Fig. 14 (232)), at least one film-feeding slot, arranged to feed film into a scanner (see Figs. 1 (40), 10g, and 15 (314) and column 4 line 61-column 5 line 8), the scanner, coupled to a control unit, for scanning at least one image from the film (see Figs. 1 (40), 10g, and 15 (314) and column 4 line 61-column 5 line 8), the printing mechanism, coupled to the control unit and arranged to receive paper from the paper-feeding slot, for printing the at least one image from the film (see column 6 lines 22-35, reference states that the computer is the central control unit for the entire system and interacts with all the attached devices), and the control unit, coupled to the printing mechanism and the scanner and arranged to initiate feeding of the paper into the printing mechanism and the film into the scanner in a predetermined fashion, for, in response to user input, causing the scanner to scan a selected portion of the film to provide the at least one image and send the at least one image to the printing mechanism and the printing mechanism to print the at least one image on the paper.

Regarding claims 2, 11, 20, and 38, Manico discloses the system discussed in claims 1, 10, 19, and 37, and further discloses wherein the at least one selected digital

image is selected from a menu of images available on the film (see Figs. 10g, 10h, 11, and 12 and column 9 lines 46-54).

Regarding claims 3 and 12, Manico discloses the system discussed in claims 2 and 11, and further discloses wherein the menu includes selection of a number of each digital image of the film that is desired to be printed (see Fig. 11 and 12 and column 9 line 63-column line 4).

Regarding claims 5, 14, 23, and 41, Manico discloses the system discussed in claims 1, 11, 20, and 38, and further discloses wherein a size of the digital image printed is selectable at the printer from a plurality of output image sizes (see column 9 lines 56-58 and column 10 line 64-column 11 line 12).

Regarding claims 9, 8, 27, and 45, Manico discloses the system discussed in claims 1, 11, 19, and 37, and further discloses wherein the film is one of: a film with a negative image and a film with a positive image (see column 3 lines 58-66, column 5 lines 9-47, and column 6 line 60-column 7 line 53).

Regarding claims 21 and 39, Manico discloses the system discussed in claims 20 and 38, and further discloses wherein the menu selection unit further provides for selection, by the user, of a designation of each image of the film that is desired to be printed (see Figs. 10g, 11, and 12 and column 9 lines 1-6 and 46-54).

Regarding claims 28 and 46, Manico discloses the system discussed in claims 19 and 37, and further discloses wherein the computer is coupled to at least one of the control unit and the scanner, for uploading scanned images to the computer for storage (see Figs. 1, 10g, and 15 (314), column 5 lines 1-6, and column 6 lines 30-33).

Regarding claims 29 and 47, Manico discloses the system discussed in claims 19 and 37, and further discloses wherein the scanner includes a first digital imaging device (see column 4 line 61-column 5 line 8).

Regarding claims 30 and 48, Manico discloses the system discussed in claims 29 and 47, and further discloses wherein the first digital imaging device is one of: a charge-coupled device and a complementary metal-oxide semiconductor (see column 4 line 61-column 5 line 8).

Regarding claims 31 and 49, Manico discloses the system discussed in claims 19 and 37, and further discloses wherein the printer includes a removable storage unit, removably coupled to the control unit and the scanner, for storing the at least one image in the removable storage unit (see Fig. 15 (318) and column 6 lines 47-53).

Regarding claims 32 and 50, Manico discloses the system discussed in claims 31 and 49, and further discloses wherein the removable storage unit is one of a flash memory card and a writable compact disc (see Fig. 15 (318) and column 6 lines 47-53).

Regarding claims 33 and 51, Manico discloses the system discussed in claims 19 and 37, and further discloses wherein the printer includes a display, coupled to the control unit and the scanner, for displaying the at least one image (see Figs. 10g, 14, and 15 and column 5 lines 1-6).

Regarding claims 35 and 53, Manico discloses the system discussed in claims 19 and 38, and further discloses wherein the menu selection unit further provides for selection of at least one of: zooming in, zooming out, cropping, removing "red eye" from

the image and directing scanning of a selected plurality of images (see column 9 lines 56-58).

Regarding claims 36 and 54, Manico discloses the system discussed in claims 19 and 37, and further discloses wherein the at least one film feeding slot is coupled to a film-feeding device that passes film over the scanner (see column 4 lines 46-49 and column 5 lines 36-47).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 13, 22, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico as applied to claims 2, 11, 20, and 38 above, and further in view of U.S. Patent No. 6157459 to Shiota et al.

Manico discloses a menu that includes selection of a desired print (see Fig. 10g).

Manico does not disclose expressly wherein the menu includes selection of a desired number of prints of each selected digital image.

Shiota discloses wherein the menu includes selection of a desired number of prints of each selected digital image (see Fig. 2 and column 4 lines 17-21, 41-44, and 49-56).

Manico & Shiota are combinable because they are from the same field of endeavor, printing images created by scanning a film.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the number of prints selection aspect of Shiota with the system of Manico.

The suggestion/motivation for doing so would have been to allow a single print to be output a plurality of times so as to increase user efficiency and decrease time wasted if only one print could be completed at any one time. It is well known in the art to allow the user to select the number of prints to be output to a printing device.

Therefore, it would have been obvious to combine Shiota with Manico to obtain the invention as specified in claims 4, 13, 22, and 40.

Claims 6-8, 15-17, 24-26, and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico as applied to claims 1, 11, 19, and 37 above, and further in view of U.S. Patent No. 6313870 to Inoue et al.

Regarding claims 6, 15, 24, and 42, Manico does not disclose expressly wherein the film slot is one of a plurality of film slots.

Inoue discloses wherein the film slot is one of a plurality of film slots (see column 3 lines 40-48, 50-52, and 60-67 and column 4 lines 18-22).

Regarding claims 7, 16, 25, and 43, Manico does not disclose expressly wherein one of the plurality of film slots is a slot arranged to accommodate a film strip for 35 mm film.

Inoue discloses wherein one of the plurality of film slots is a slot arranged to accommodate a film strip for 35 mm film (see column 3 lines 60-67).

Regarding claims 8, 17, 26, and 44, Manico does not disclose expressly wherein one of the plurality of film slots is a slot arranged to accommodate a slide for 35 mm film.

Inoue discloses wherein one of the plurality of film slots is a slot arranged to accommodate a slide for 35 mm film (see column 3 lines 60-67).

Manico & Inoue are combinable because they are from the same field of endeavor, digitizing photographic film.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the plurality of different input adaptors arranged to accommodate slides and film strips for 35 mm film, the idea as described by Inoue with the system of Manico.

The suggestion/motivation for doing so would have been provide a plurality of different input film slots to allow different types and sizes of film to be processed as is commonly practiced in the art.

Therefore, it would have been obvious to combine Inoue with Manico to obtain the invention as specified in claims 6-8, 15-17, 24-26, and 42-44.

Claims 34 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico as applied to claims 33 and 51 above, and further in view of U.S. Patent No. 6122069 to Kendall et al.

Manico does not disclose expressly wherein the display is further coupled to a second digital imaging device to show live pictures being captured by the second digital imaging device and to allow the user to center the at least one image before printing.

Kendall discloses wherein the display is further coupled to a second digital imaging device to show live pictures being captured by the second digital imaging device and to allow the user to center the at least one image before printing (see Fig. 6, column 2 lines 34-48, and column 6 lines 36-47).

Manico & Kendall are combinable because they are from the same field of endeavor, scanning and printing of images.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the display of a live image, which is being captured by a scanner, and the manipulation of said image as described by Kendall with the system of Manico.

The suggestion/motivation for doing so would have been to provide image repair and manipulation prior to saving an image to provide a user with more control appearance of the final image as is most commonly done in systems with plate scanners and associated software for personal computers.

Therefore, it would have been obvious to combine Kendall with Manico to obtain the invention as specified in claims 34 and 52).

Claims 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico.

Regarding claim 55, Manico discloses wherein the control unit sends scanned information to the printing mechanism for printing without intermediate storage of the scanned information (see Fig. 10g and column 5 lines 1-6, reference shows that the images can be selected for printing without being stored in memory which is analogous to the claim limitation).

Manico does not disclose expressly wherein the control unit includes a processor programmed with a predetermined scheme that sends scanned information to the printing mechanism for printing without intermediate storage of the scanned information.

However, it is well known in the art that a control unit can be programmed with a predetermined scheme to send scanned information to the printer without intermediate storage of the scanned information, which can be seen commonly in plate scanners attached to personal computers for scanning and printing images which send the image directly from the scanner to the printer without intermediate storage of the image. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a control unit that can be programmed with a predetermined scheme to send scanned information to the printer without intermediate storage of the scanned information.

Regarding claim 56, Manico discloses wherein the scanner sends scanned information to the printing mechanism for printing without intermediate storage of the scanned information (see Fig. 10g and column 5 lines 1-6, reference shows that the

images can be selected for printing without being stored in memory which is analogous to the claim limitation).

Manico does not disclose expressly wherein the scanner includes a processor programmed with a predetermined scheme that sends scanned information to the printing mechanism for printing without intermediate storage of the scanned information.

However, it is well known in the art that a scanner can be programmed with a predetermined scheme to send scanned information to the printer without intermediate storage of the scanned information, which can be seen commonly in plate scanners attached to personal computers for scanning and printing images which send the image directly from the scanner to the printer without intermediate storage of the image. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a scanner that can be programmed with a predetermined scheme to send scanned information to the printer without intermediate storage of the scanned information.

Thus, it would have been obvious to alter Manico with information known in the art to obtain the invention in claims 55 and 56.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art refer to U.S. Patent numbers 5388252 (Dreste et al.), 5430525 (Ohta et al.), 5617185 (North), 5841885 (Neff et al.),

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5917929 (Marshall et al.), 5940169 (Masutani), 6353487 (Fredlund et al.), 6670988 (Gallagher et al.), and 6765691 (Kubo et al.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia
Examiner
Art Unit 2622

MRM

JOSEPH R. POKRZYWA
PRIMARY EXAMINER
ART UNIT 2622

